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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/440,557
Filing Date: November 15, 1999
Appellant(s): LIPSCHER ET AL.

John R. Schell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/11/07 appealing from the Office action mailed 4/11/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

(A) Claims 25-29, 33-46, 65, 73, 74 and 79-89 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter. Based on Supreme

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Court precedent¹[1] and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. ²[2] If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

However, claims 25-29, 33-46, 65, 73, 74 and 79-89 does not seem to fall within one of the recognized categories. The method as claimed can be performed in the mind of a user, by paper and pencil, or by a machine. These steps constitute the idea of managing healthcare related information and displaying healthcare advertisements. One may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent in practical effect, would be a patent of the [abstract idea] itself." *Benson*, 409 U.S. at 71-72, 175 USPQ at 676; *cf. Diehr*, 450 U.S. at 187, 209 USPQ at 8.

The above deficiency can be overcome by expressly stating in the body of the claimed method, using a computer (apparatus) or terminal, for example, which makes the claim useful.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,845,255	MAYAUD	12-1998
6,385,592	ANGLES et al.	5-2002
6,018,713	COLI et al.	1-2000

¹[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

²[2] The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

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PR Newswire, "GoToWorld.com Named Fastest Growing Web Browser in World, Aug 24, 1999, New York, pg. 1

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

(A) Claims 25-29, 33-46, 65, 73, 74 and 79-89 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent^{3[1]} and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. ^{4[2]} If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

However, claims 25-29, 33-46, 65, 73, 74 and 79-89 does not seem to fall within one of the recognized categories. The method as claimed can be performed in the mind of a user, by paper and pencil, or by a machine. These steps constitute the idea of managing healthcare related information and displaying healthcare advertisements. One may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent in practical effect, would be a patent of the [abstract idea] itself." *Benson*, 409 U.S. at 71-72, 175

^{3[1]} *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

^{4[2]} The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

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USPQ at 676; *cf. Diehr*, 450 U.S. at 187, 209 USPQ at 8.

The above deficiency can be overcome by expressly stating in the body of the claimed method, using a computer (apparatus) or terminal, for example, which makes the claim useful.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 79-85 and 86-89 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 5,845,255 to Mayaud.

As per claim 79, Mayaud teaches a computer-implemented method for preparing a prescription, the method comprising:

--the claimed providing a pharmaceutical advertisement to an interface device is met by the drug list view by the physician on screen (see: column 35, lines 1-17); and

--the claimed populating a prescription form based on selection of the pharmaceutical advertisement via the interface device is met by the prescription management system providing a list of formulary drugs displayed to the physician and if the physician is satisfied with the formulary drugs offered by the prescription management system any one formulary drug may be selected and automatically posted to the prescription (see: column 35, lines 38-43 and column 36, lines 26-30).

As per claims 80 and 81, Mayaud teaches the claimed populating the prescription form includes initializing prescription parameters wherein the prescription parameters are selected

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from the group consisting of dosage, frequency, form and duration is met by the prescription quantification that include form, size, and amount (see: column 26, lines 10-38 and Fig. 3).

As per claims 82 and 83, Mayaud teaches the claimed prescription parameters are determined based on information associated with a patient and the information associated with the patient includes data associated with patient weight. The feature is met by the system calculating or suggesting effective dosage for a patient according to a dosage-relevant patient characteristics, for example, height weight, age, sex, pregnancy and the like (see: column 26, lines 39-46).

As per claims 84 and 85, Mayaud teaches the claimed populating the prescription form includes providing treatment regimen and the treatment regimen includes strength, quantity, method of delivery, frequency, and duration of treatment. This limitation is met the prescription quantification that include form, size, and amount (see: column 26, lines 10-38 and Fig. 3).

As per claims 87-88, Mayaud teaches the claimed receiving patient medical data from the interface device and the patient medical data includes data associated with a patient condition. This limitation is met by the patient condition (116, Fig. 5) and the list of drug used to effectively treat the patient's condition entered via desktop computers with different input devices such keyboards, touch pads or touch screen (see: column 35, lines 1-17 and Fig. 12 and column 7, lines 46-67).

As per claim 89, Mayaud teaches the claimed providing the pharmaceutical advertisement is based on the patient medical data. This limitation is met by patient condition (116, Fig. 5) and the list of drug used to effectively treat the patient's condition (see: column 35, lines 1-17 and Fig. 12).

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-7, 9-10, 13, 25-29, 33-44, 64-65, 73, 77, 91 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,385,592 to Angles et al. and U.S. Patent No. 6,018,713 to Coli et al. in view of U.S. Patent No. 5,845,255 to Mayaud.

As per claim 2, Angles et al. teaches a system and method for delivering customized advertisements to users of interactive device including computers connected to on-line services, interactive kiosks (reads on “devices for enabling entry” and “display to the user”), interactive television system and the like (see: column 2, lines 49-62 and abstract). The system includes a consumer computer (10, Fig. 1), a content provider computer (14, Fig. 1) and advertisement provider computer (18, Fig. 1) (reads on “a advertising selecting computer”), which communicate with each other by use of a communication medium (20, Fig. 1) (reads on “a communications network for transmitting information”) (see: column 7, lines 60-64). In addition, Angles et al. further teaches that a consumer directs the consumer computer (12, Fig. 1) to communicate with content provider computer (14, Fig. 1) via the communication medium (20, Fig. 1) and based the consumer’s profile, the advertisement provider computer (18, Fig. 1) selects an appropriate customized advertisement (30, Fig. 1) then sends it to the consumer computer (12, Fig. 1) (reads on “advertising selecting computer compares related information to the advertising information and selects advertising information for display to the user”) (see:

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column 7, lines 65 to column 8, lines 28). Additionally, Angles et al. teaches that the advertisement provider computer (18, Fig. 4) utilizes a variety of modules to store customer information and to generate customized advertisements (30, Fig. 1). The modules include a registration module (60 Fig. 4), an advertising module (62, Fig. 4), a registration database (68, Fig. 4), an advertisement database (70, Fig. 4) and an accounting database (72, Fig. 4) (reads on “database for storing information connected to consumer’s computer”) (see: column 13, lines 34-47 and column 15, lines 32-43).

Angles et al. fails to teach the targeting of healthcare related information and healthcare product information to a computer user as well as the advertising selecting computer transmitting a pharmaceutical advertisement to at least one of the plurality of devices for display via the communication network and, in response to the computer user selecting the displayed pharmaceutical advertisement, prescription form is automatically populated.

Coli et al. teaches a network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office that includes advertising for a particular drug treatment or medical device that may be needed by the patient as part of the test results reporting output (see: column 4, lines 25-35 and abstract). In addition, Coli et al. teaches a client computer is programmed to display advertising and product information after receiving a request the user’s computer (see: column 7, lines 25-47).

Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to include the advertisement of drug treatment and medical devices as taught by Coli et al. within the delivery of customized advertisements as taught by Angles et al. with the

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motivation of trying to successfully promoting a product or service to a targeted audience according a user profile.

Angles et al. and Coli et al. fail to teach in response to selected an pharmaceutical advertisement, a prescription form is automatically populated.

Mayaud teaches a electronic prescription creation system where a list of formulary drugs may be displayed to the physician and if the physician is satisfied with the formulary drugs offered by the prescription management system any one formulary drug may be selected and automatically posted to the prescription (see: column 35, lines 38-43 and column 36, lines 26-30).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include the prescription management system as taught by Mayaud with the system of Angles et al. and Coli et al. with the motivation of reducing prescription cost to the patients and to their drug benefit management company or government agency (see: Mayaud: column 4, lines 25-29).

As per claim 3, Angles et al., Coli et al. and Mayaud fail to explicitly teaches healthcare related information comprises information received from a healthcare group consisting of healthcare providers, patients, healthcare service organizations, pharmaceutical companies, healthcare product and service vendors, pharmacies, medical facilities, healthcare information services, medical record databases, government agencies, non-profit organizations, health research organizations and billing companies.

However, Angles et al., Coli et al. and Mayaud teach a network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office

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computers (202, 204, 206, 208, Fig. 2) that includes advertising for a particular drug treatment or medical device that may be needed by the patient as part of the test results reporting output (see: Coli et al.: column 4, lines 25-35, column 9, lines 4-22 and abstract). The Examiner considers modifying the hospital and physician office to include the above mentioned healthcare group an obvious modification to system of Angles et al. and Coli et al.

One of ordinary skill in the art at the time the invention was made would have found it obvious to include a healthcare group consisting of healthcare providers, patients, healthcare service organizations, pharmaceutical companies, healthcare product and service vendors, pharmacies, medical facilities, healthcare information services, medical record databases, government agencies, non-profit organizations, health research organizations and billing companies within the system as taught by Angles et al., Coli et al. and Mayaud with the motivation of receiving information from a number of people in the medical community to better target advertisement more suited to their profession.

As per claim 4, Angles et al. teaches database of stored non-healthcare related information connected to the advertising selecting computer wherein the advertising selecting computer compares the healthcare related information and the non-healthcare information to the advertising information and selects advertising information for display to the user that is related to the non-healthcare information. This feature is met by the consumer computer (12, Fig. 1) that communicates with the content provider computer (14, Fig. 1) via the communication medium (20, Fig. 1) and based on the consumer's profile, the advertisement provider computer (18, Fig. 1) selects an appropriate customized advertisement (30, Fig. 1) then sends it to the consumer computer (12, Fig. 1) (reads on "advertising selecting computer compares related information to

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the advertising information and selects advertising information for display to the user”) (see: column 7, lines 65 to column 8, lines 28). Angles et al. further teaches that the advertisement provider computer (18, Fig. 4) utilizes a variety of modules to store customer information and to generate customized advertisements (30, Fig. 1). The modules include a registration module (60 Fig. 4), an advertising module (62, Fig. 4), a registration database (68, Fig. 4), an advertisement database (70, Fig. 4) and an accounting database (72, Fig. 4) (reads on “database for storing information connected to consumer’s computer”) (see: column 13, lines 34-47 and column 15, lines 32-43).

As per claim 5, Angles et al. teaches the claimed devices is a wireless portable computer device (see: column 10, lines 43-48).

As per claim 6, Angles et al. teaches the device is selected from the group consisting of web TV devices, personal digital assistant devices, personal computers, handheld portable computers, portable computers, wireless telephone devices and wireless personal access devices. This limitations is met by the consumer computer (12, Fig. 1) that could be a computer workstation, a local area network of computer, an interactive television, an interactive kiosk, a personal digital assistant, an interactive wireless communications device or the like (see: column 10, lines 43-48).

As per claim 7, Angles et al. teaches a system that includes a consumer computer (10, Fig. 1), a content provider computer (14, Fig. 1) and advertisement provider computer (18, Fig. 1), which communicate with each other by use of a communication medium (20, Fig. 1) (see: column 7, lines 60-64).

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Angles et al. fails to the advertising selecting computer constructs a medical record for a patient using healthcare information selected from at least one of the healthcare group and transmits the medical record via the communications network to the computer user.

Coli et al. teaches an advertising process that begins when recent test result values are compared to information in a database, using an expert system based on patient demographics, medical history, and the available test results, whether any of the values are abnormal or whether the patient record indicates a potential need for particular medical items. If the patient records indicates a need for particular medical item or drug an advertisement for a drug or other medical device is selected and transmitted to the physician or hospital computers (see: column 16, lines 40-55).

The obviousness for combining the teachings of Coli et al. and Angles et al. are discussed in the rejection of claim 2, and incorporated herein.

As per claims 9-10, Mayaud teaches a electronic prescription creation system where a list of formulary drugs may be displayed to the physician and if the physician is satisfied with the formulary drugs offered by the prescription management system any one formulary drug may be selected and automatically posted to the prescription (see: column 35, lines 38-43 and column 36, lines 26-30).

As per claim 13, Angles et al., Coli et al. and Mayaud teach the claimed communications network is selected from the group consisting of a global communication network, a wide area network, a local area network, a wireless telephone network, a satellite network, an interactive television network and a cable network. This limitation is met by the wide range of interactive communication mediums used such as interactive television networks, telephone networks,

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wireless data transmission systems, two-way cable systems, customized computer networks, interactive kiosk networks, automatic teller machine networks, and the like (see: Angeles et al.: column 9, lines 37-43).

As per claim 25, Angeles et al., Coli et al. and Mayaud teach a network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office (reads on “using patient medical information and healthcare provider information collected from at least one of a plurality of sources”) that includes advertising for a particular drug treatment or medical device that may be needed by the patient as part of the test results reporting output (see: Coli et al.: column 4, lines 25-35 and abstract). In addition, Angeles et al., Coli et al. and Mayaud teaches a client computer is programmed to display advertising and product information after receiving a request from the user’s computer (see: Coli et al.: column 7, lines 25-47).

Angeles et al., and Coli et al. fail to teach automatically populating a healthcare produce order form.

Mayaud teaches a electronic prescription creation system where a list of formulary drugs may be displayed to the physician and if the physician is satisfied with the formulary drugs offered by the prescription management system any one formulary drug may be selected and automatically posted to the prescription (see: column 35, lines 38-43 and column 36, lines 26-30).

The obviousness of combining the teachings of Mayaud with the system of Angeles et al. and Coli et al. are discussed in the rejection of claim 2, and incorporated herein.

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As per claims 26 and 29, Coli et al. teaches a network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office that includes advertising for a particular drug treatment or medical device that may be needed by the patient as part of the test results reporting output (see: column 4, lines 25-35 and abstract). Furthermore, a client computer is programmed to display advertising and product information after receiving a request the user's computer (see: column 7, lines 25-47). The Examiner considers the data received and the information requested by the user's computer regarding the display of an advertisement and product information to the users to also include a group consisting of health care provider information, patient medical records, patient prescription records, patient entered information, medical test ordering and test result records, and health information.

As per claim 27, Coli et al. teaches the claimed product advertisement comprises a pharmaceutical advertisements. This feature is met by the network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office that includes advertising for a particular drug treatment (pharmaceutical advertisement) or medical device that may be needed by the patient as part of the test results reporting output (see: column 4, lines 25-35 and abstract).

As per claim 28, Angles et al. teaches the claimed at least one of the plurality of sources comprises collected user entered data and user actions as a user navigates through an electronic web page display (see: column 7, lines 65 to column 8, lines 5).

As per claim 33, Mayaud teaches the claimed wherein populating a healthcare product order form includes initializing parameters of a prescription to values based on the patient

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medical information (see: column 20, lines 50-67). This limitation is met by patient condition (116, Fig. 5) and the list of drug used to effectively treat the patient's condition (see: column 35, lines 1-17 and Fig. 12).

As per claim 34, Mayaud teaches the claimed further comprising sending of the sending the prescription to patient-selected pharmacy. This limitation is met by the electronic prescription creation system for physician, which can be transmitted across a network for fulfillment by a specified pharmacy according to the patient drug benefit plan (see: column 27, lines 30-50).

As per claim 35, Mayaud teaches that if the prescription contains at least one refill, at least one prescription refill is not sent to the patient-selected pharmacy and is electronically stored for the patient. This feature is met by the electronic prescription system using the Refill field (100, Fig. 3) that shows the number of refills permitted as well as back calculating refills (see: column 26, lines 31-60). The Examiner considers the refill field that stores the number of refills capable of not sending a prescription to the pharmacy if there is only one refill left.

As per claim 36, Mayaud teaches the claimed electronically stored prescription refill is sent to the patient-selected pharmacy upon request of the patient (see: column 27, lines 30-50).

As per claims 37-43, Angles et al. and Coli et al. teaches a network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office that includes advertising for a particular drug treatment or medical device that may be needed by the patient as part of the test results reporting output (see: Coli et al.: column 4, lines 25-35 and abstract). In addition, Coli et al. teaches a client computer is programmed to display

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advertising and product information after receiving a request from the user's computer (see: Coli et al.: column 7, lines 25-47).

Angles et al. and Coli et al. fail to teach filtering of patient medical information including displaying or not displaying drugs the patient is allergic to.

Mayaud teaches a Problem button (50, Fig. 3) that brings up a patient problem history information screen as shown in Fig. 12 which includes patient's drug related allergies, or drug reactions (filtering) and is activated by the Allergies button (52, Fig. 3) (see: column 20, lines 20-40).

The obviousness for combining the teachings of Mayaud in the system of Angles et al. and Coli et al. are discussed in the rejection of claim 2, and incorporated herein.

As per claim 44, Angles et al. and Coli et al. teaches a network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office that includes advertising for a particular drug treatment or medical device that may be needed by the patient as part of the test results reporting output (see: Coli et al.: column 4, lines 25-35 and abstract). In addition, Coli et al. teaches a client computer is programmed to display advertising and product information after receiving a request the user's computer (see: Coli et al.: column 7, lines 25-47).

Angles et al. and Coli et al. fails to teach filtering pharmaceutical advertisements for drugs that are not included in the formulary of the patient's insurance company.

Mayaud teaches that the patient record including the patient's histories can show not only the drugs prescribed, but also the conditions for which they were prescribed, allergies, demographics, insurance coverage, treating health care providers, and so on (see: column 21,

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lines 33-37). In addition, Mayaud teaches a Problem button (50, Fig. 3) that brings up a patient problem history information screen as shown in Fig. 12 which includes patient's drug related allergies, or drug reactions (filtering) and is activated by the Allergies button (52, Fig. 3) (see: column 20, lines 20-40).

The obviousness for combining the teachings of Mayaud in the system of Angles et al. and Coli et al. are discussed in the rejection of claim 2, and incorporated herein.

As per claim 64, Angles et al. teaches a system and method for delivering customized advertisements to users of interactive device including computers connected to on-line services, interactive kiosks, interactive television system and the like (see: column 2, lines 49-62 and abstract). The system includes a consumer computer (10, Fig. 1), a content provider computer (14, Fig. 1) and advertisement provider computer (18, Fig. 1), which communicate with each other by use of a communication medium (20, Fig. 1) (see: column 7, lines 60-64). In addition, Angles et al. further teaches that a consumer directs the consumer computer (12, Fig. 1) to communicate with content provider computer (14, Fig. 1) via the communication medium (20, Fig. 1) and based the consumer's profile, the advertisement provider computer (18, Fig. 1) selects an appropriate customized advertisement (30, Fig. 1) then sends it to the consumer computer (12, Fig. 1) (see: column 7, lines 65 to column 8, lines 28). Additionally, Angles et al. teaches that the advertisement provider computer (18, Fig. 4) utilizes a variety of modules to store customer information and to generate customized advertisements (30, Fig. 1). The modules include a registration module (60 Fig. 4), an advertising module (62, Fig. 4), a registration database (68, Fig. 4), an advertisement database (70, Fig. 4) and an accounting database (72, Fig. 4) (see: column 13, lines 34-47 and column 15, lines 32-43).

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Angles et al. fails to explicitly teach:

--the claimed displaying targeted healthcare product information, prescription writing habits of a healthcare provider, selecting a healthcare advertisement for display to a user that is related to the at least one of the plurality of sources and transmitting the healthcare advertisement for electronically displaying to the user; and

--the claimed in response to selection of the healthcare advertisement, automatically populating a healthcare product order form.

Coli et al. teaches a network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office that includes advertising for a particular drug treatment or medical device that may be needed by the patient as part of the test results reporting output (see: column 4, lines 25-35 and abstract). In addition, Coli et al. teaches a client computer is programmed to display advertising and product information after receiving a request the user's computer (see: column 7, lines 25-47). Furthermore Coli et al. teaches at block 1710, that the computer using a communications network, such as the internet or a private network is used to create a complete cumulative results reporting record for that patient (see: column 18, lines 3-8).

The obviousness for combining the teachings of Coli et al. and Angles et al. are discussed in the rejection of claim 2, and incorporated herein.

Angles et al. and Coli et al. fail to teach the prescription writing habits of a healthcare provider and in response to selection of the healthcare advertisement, automatically populating a healthcare product order form.

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Mayaud teaches a manually maintainable problem record maintenance screen for physician to maintain their own personal customized prescription, diagnosis, allergy or other useful lists to supplement the automatically maintained system lists (see: column 44, lines 19-48 and Fig. 14). In addition, Mayaud teaches an electronic prescription creation system for physician which can be transmitted across a network for fulfillment by a specified pharmacy according to the patient drug benefit plan (see: column 27, lines 30-50). Moreover, Mayaud teaches a electronic prescription creation system where a list of formulary drugs may be displayed to the physician and if the physician is satisfied with the formulary drugs offered by the prescription management system any one formulary drug may be selected and automatically posted to the prescription (see: column 35, lines 38-43 and column 36, lines 26-30).

The obviousness for combining the teachings of Mayaud in the system of Angles et al. and Coli et al. are discussed in the rejection of claim 2, and incorporated herein.

As per claim 65, it is rejected for the same reasons set forth in claim 26.

As per claims 73 and 77, Angles et al., Coli et al. and Mayaud all use a computer system with software to run all the programs performed on the system (see: Angles et al.: column 3, lines 21-30, Coli et al. column 9, lines 4-17 and Mayaud column 45, lines 10-28, column 46, lines 23-31 and Fig. 16).

As per claims 91 and 92, they are rejected for the same reasons set forth in claims 2 and 25.

7. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,385,592 to Angles et al. and U.S. Patent No. 6,018,713 to Coli et al. and U.S. Patent No.

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5,845,255 to Mayaud as applied to claim 2 above, and further in view of "GoToWorld.com Named Fastest Growing Web Browser in World" by PR Newswire (hereinafter "Newswire").

As per claims 11-12, Angles et al., Coli et al. and Mayaud teach the use of an advertising module (62, Fig. 4) that determines the appropriate amount to debited or credited to accounts of the content provider, customer and advertiser for viewing an advertisement and then stores the advertising audit information in the accounting database (72, Fig. 72) (see: Angeles et al.: column 21, lines 9-36 and Fig. 8).

Angles et al., Coli et al. and Mayaud fail to explicitly teach calculating a revenue amount to be paid using a computer system for referral to a website.

Newswire teaches GoToWorld.com web browser that allows user to be paid 40 cent an hour while they are surfing the Internet using the web browser (see: paragraph 2). In addition, each member earns a referral fee for each hour his or her referrals stay online (see: paragraph 2). Newswire also teaches a revolutionary revenue sharing technique where GoToWorld.com is able to pay members because of an innovative advertising revenue sharing process called "browsing pay" (see: paragraphs 6-8).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include GoToWorld.com ability to calculate a revenue amount to be paid for referral to a website as taught by Newswire with the system as taught by Angles et al., Coli et al. and Mayaud with the motivation of providing relevant and significant information to an individual informing him of the new or improved product or service.

8. Claims 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,385,592 to Angles et al. and U.S. Patent No. 6,018,713 to Coli et al. and U.S. Patent No.

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5,845,255 to Mayaud as applied to claim 29 above, and further in view of U.S. Patent

Application Pub. No. 2001/0042064 to Davis et al.

As per claims 45-46, Angles et al., Coli et al. and Mayaud teaches the use of an advertising module (62, Fig. 4) that determines the appropriate amount to debited or credited to accounts of the content provider, customer and advertiser for viewing an advertisement and then stores the advertising audit information in the accounting database (72, Fig. 72) (see: Angeles et al.: column 21, lines 9-36 and Fig. 8).

Angles et al., Coli et al. and Mayaud fail to explicitly teach prioritizing display order according to an amount of revenue received for displaying each advertisement.

Davis et al. teaches a system and method that enables information providers (advertisers) using a computer network to determine what position or rank their web site description will appear on a web page according money spend at the main web site (see: paragraph 27).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include prioritizing display order according to an amount of revenue received for displaying each advertisement as taught by Davis et al. with the system as taught by Angles et al., Coli et al. and Mayaud with the motivation of providing promoters the ability to influence a higher placement in a search result list via a continuous, competitive online bidding process (see: Davis et al.: paragraph 18).

9. Claims 86 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,845,255 to Mayaud and U.S. Patent No. 6,385,592 to Angles et al.

As per claim 86, Mayaud fails to teach the claimed crediting a healthcare provider account based on selection of the pharmaceutical advertisement.

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Angles et al. teaches the use of an advertising module (62, Fig. 4) that determines the appropriate amount to debited or credited to accounts of the content provider, customer and advertiser for viewing an advertisement and then stores the advertising audit information in the accounting database (72, Fig. 72) (see: Angeles et al.: column 21, lines 9-36 and Fig. 8).

One of ordinary skill in the art at the time the invention was made would have found it obvious to an advertising module as taught by Angles et al. with the prescription creation system as taught by Mayaud with the motivation of providing relevant and significant information to an individual informing him of the new or improved products or services.

As per claim 90, Mayaud teaches a computer system comprising:

--the claimed processor is met by intelligent data processing device having a processor (see: column 53, lines 62-67); and

--the claimed storage accessible by the processor, the storage including:

--the claimed program instructions operable by the processor to provide a pharmaceutical advertisement to the interface device is met by the drug list view by the physician on screen (see: column 35, lines 1-17). In addition, the program language used to write system software depends upon the environment of the various system components (see: column 51, lines 12-25); and

--the claimed program instructions operable by the processor to populate a prescription form based on selection of the pharmaceutical advertisement via the interface device is met by the prescription management system providing a list of formulary drugs displayed to the physician and if the physician is satisfied with the formulary drugs offered by the prescription management system any one formulary drug may be selected and automatically posted to the prescription (see: column 35, lines 38-43 and column 36, lines 26-30 and column 51, lines 12-

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25). In addition, the program language used to write system software depends upon the environment of the various system components (see: column 51, lines 12-25).

(10) Response to Argument

In the Appeal Brief filed 11 July 2007, Appellant makes the following arguments:

(A) Mayaud does not teach or suggest populating a prescription form based on selection of the pharmaceutical advertisement via the interface device as recited in claim 79.

(B) The cited reference fails to teach or suggest a prescription form is automatically populated in response to a computer user selecting the displayed advertisement as recited in claim 2.

(C) The cited reference fails to teach or suggest automatically populating a healthcare product order form in response to a computer user selecting the displayed advertisement as recited in claim 25.

(D) The cited references fail to teach or remotely suggest automatically populating a healthcare product order form in response to selection of the healthcare advertisement as recited in claim 64.

(E) The cited references fail to teach or remotely suggest a prescription is initiated based on the healthcare related information in response to a computer user selecting the displayed pharmaceutical advertisement as recited in claim 91.

(F) The cited references fail to teach or remotely suggest automatically initiating a healthcare product order form based on the patient medical information in response to selection of the product advertisement as recited in claim 92.

(G) The combined cited references, Newswire does not teach or suggest calculating an amount to be paid to a healthcare provider for referring patients to a health information website as recited in claim 12.

(H) The cited reference fail to teach or remotely suggest program instructions operable by the processor to populated a prescription form based on selection of the pharmaceutical advertisement via the interface device as recited in claim 90.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Response to Arguments (A) - (D) and (H):

In response to the first - fourth arguments, the Examiner respectfully submits that reference of Coli et al. is relied on for teaching a network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office that includes **advertising for a particular drug treatment** (reads on "pharmaceutical advertisement") or medical device that may be needed by the patient as part of the test results reporting output (see: column 4, lines 25-35 and abstract). In addition, Coli et al. teaches a client computer programmed to **display advertising and product information after receiving a request from the user's computer** (reads on "in response to the computer user selecting the displayed advertisement") (see: column 7, lines 25-47). The Mayaud reference is relied on for teaching a electronic prescription creation system where a list of formulary drugs may be displayed to the physician and if the physician is satisfied with the formulary drugs offered by the prescription management system any one formulary drug may be selected and **automatically posted to the prescription** (reads on "a prescription form is automatically populated") (see: column 35, lines 38-43 and column 36, lines 26-30). In addition, Mayaud also teaches that program language is

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used to write system software that depends upon the environment of the various system components (see: column 51, lines 12-25). Therefore, the Examiner agrees with the cited definition of the term “advertisement” in the Cambridge Dictionary of American English. However, as mentioned above the Coli et al. reference is relied on for teaching a display of a pharmaceutical advertisement and not Mayaud description of “a list of formulary drugs”.

Response to Argument (E) and (F):

In response to the fifth and sixth argument, the he Examiner respectfully submits that the Mayaud reference, and not Angles and Coli, *per se*, that was relied upon for the specific teaching of a electronic prescription creation system using a list of formulary drugs which displayed to the physician and if the physician is satisfied with the formulary drugs offered by the prescription management system any one formulary drug may be selected and automatically posted to the prescription (reads on “automatically initiating a prescription or healthcare product order”) (see: column 35, lines 38-43 and column 36, lines 26-30). Angles and Coli was relied on for primarily teaching of a system and method for delivering customized advertisements to users of interactive device including computers connected to on-line services, interactive kiosks, interactive television system and the like (see: Angles et al.: column 2, lines 49-62 and abstract). The system includes a consumer computer (10, Fig. 1), a content provider computer (14, Fig. 1) and advertisement provider computer (18, Fig. 1) (see: Angles et al.: column 7, lines 60-64). In addition, Angles et al. further teaches that a consumer directs the consumer computer (12, Fig. 1) to communicate with content provider computer (14, Fig. 1) via the communication medium (20, Fig. 1) and based the consumer’s profile, the advertisement provider computer (18, Fig. 1) selects an appropriate customized advertisement (30, Fig. 1) then sends it to the consumer

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computer (12, Fig. 1) (see: Angles et al.: column 7, lines 65 to column 8, lines 28). Thus, the proper combination of the applied references would be the incorporation of Mayaud's system for electronic prescription creation with the system as taught by Angles and Coli.

Response to Argument (G):

In response to the seventh argument, the Examiner respectfully submits that the Angles et al., Coli et al. and Mayaud references teach the use of an advertising module (62, Fig. 4) that determines the appropriate amount to debited or credited to accounts of the content provider, customer and advertiser for viewing an advertisement and then stores the advertising audit information in the accounting database (72, Fig. 7) (see: Angeles et al.: column 21, lines 9-36 and Fig. 8). The Newswire reference is relied on for teaching GoToWorld.com web browser that allows user to be paid 40 cent an hour while they are surfing the Internet using the web browser (see: paragraph 2). In addition, each member earns a referral fee for each hour his or her referrals stay online (see: paragraph 2). Newswire also teaches a revolutionary revenue sharing technique where GoToWorld.com is able to pay members because of an innovative advertising revenue sharing process called "browsing pay" (see: paragraphs 6-8). This clearly shows that hourly compensation such as a referral fee is given to a member (healthcare provider) for each referral (patient) that using the web site.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,


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/Robert Morgan/
Primary Examiner, Art Unit 3626

**A Technology Center Director or designee must personally approve the new
ground(s) of rejection set forth in section (9) above by signing below:**



Conferees:



Luke Gilligan
Supervisory Patent Examiner
Tech Center 3600

WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR

Vincent Millin
Appeals Conference Specialist
Tech Center 3600

